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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/902,321

07/10/2001

Michael Lee Vatter

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27752 7590 11/09/2009  
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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

11/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/902,321	<b>Applicant(s)</b> VATTER ET AL.	
	<b>Examiner</b> GINA C. YU	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on July 15, 2009. The claim rejections indicated in the previous Office action dated January 26, 2009 are withdrawn in view of the claim amendment made by applicant.

New rejections are made to address the new claim limitations.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, the new limitation, "and wherein at least 10 % of the droplets are greater than 40 microns and at least 10 % of the droplets are greater than 60 microns" is not supported by applicant's original disclosure. The specification, p. 11, bridging paragraph, indicates that in the discontinuous phase droplets have a droplet size distribution range "such that at least 20 %, preferably 15 %, more preferably 10 % of the droplet size of greater than 40 microns, more preferably greater than 60 microns, most preferably greater than 75 microns, and optimally greater than 40 microns". The

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specification may support a droplet size distribution wherein at least 20 %, or at least 15 %, or at least 10 % of the droplets have the size greater than 40 microns or a distribution wherein at least 20 %, or at least 15 %, or at least 10 % of the droplets have the size greater than 60 microns. Although the present limitation reads on a droplet size distribution range of at least 20 % of the droplet size of greater than 60 microns, which is supported by the specification, the limitation also encompasses a size distribution wherein at least 10 % of the droplets are greater than 40 microns (e.g., 41-100 microns) and at least 10 % of the droplets are greater than 60 microns (e.g., 61-100 microns). Such combined size distributions within a droplet size distribution range is new, as the specification does not reasonably convey to a skilled artisan that applicant had possession of the presently claimed size distribution at the time of the invention.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tachibana et al. (5,412,004) in view of Tchinnis et al. (US 6379682).**

Tachibana is directed to the manufacture of paste-like silicone compositions that can be used in water-in-oil cosmetic emulsions (title and abstract, in a water-in-oil emulsion, water is the discontinuous phase and oil is the continuous phase). Applicant discloses at page 5, lines 4- 11 and page 6, lines 12-14 that the emulsifying crosslinked siloxane elastomers are those disclosed by Tachibana. The water-in-oil cosmetic

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emulsion of Tachibana may contain various components in the discontinuous phase such as saccharides, sugar alcohols, inorganic salts, polyoxyalkylene-modified organopolysiloxane emulsifiers (surfactants) and cosmetic powders, such as talc, kaolin, mica, titanium dioxide, zinc oxide, red iron oxide, and others (col. 3, line 55 to col. 4, line 18, and Col. 10, line 61-Col. 11, line 6). For solids such as organically modified montmorillonite clay, see col. 8, lines 38-47. For sorbitol, a polyhydric alcohol of claim 4, see col. 9, lines 28-29. For dimethicone copolyol emulsifier, see col. 9, line 38 to col. 10, line 53.

For additional solids and fillers, see col. 10, line 57 to col. 11, line 6. For preservatives and skin conditioning agents such as moisturizers, which include emollients, see col. 11, lines 53- 57. See examples 15-27 for preservatives and forms of the compositions such as foundation, eye shadow, and rouge (blusher).

Tachibana discloses at col. 7, lines 33-39 that the paste-like composition comprises 100 parts by weight of the silicone polymer (emulsifying siloxane elastomer) and 10-1000 parts by weight of a silicone oil. This is equivalent to 9-90 wt.% of each of the components, which overlaps the instantly claimed percent ranges of claim 14.

With respect to the claim limitation “wherein at least 10 % of the droplets are greater than 40 microns and at least 10 % of the droplets are greater than 60 microns”, Tachibana does not teach the droplet size distribution range of the discontinuous phase and the average particle size of the emulsifying crosslinked siloxane elastomer. The droplet size of the discontinuous phase is a function of the emulsifier and its

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concentration used in an emulsion, and may also be affected by the process of making the emulsion. See Tchinnis et al. (US 6379682 B1). It is viewed that an emulsion made as according to the teachings and suggestions of the Tachibana reference would result in the claimed composition, since the reference teaches all the claimed components including the emulsifying crosslinked silicone elastomer of the claimed invention, to make a multiphase emulsion. The resulting droplet size distribution of the composition would have been obviously observed to the skilled artisan.

Applicant asserts that the claimed composition results in unexpected droplet size. However, the argument is not commensurate with the scope of the claims because the claim is not limited to any specific weight amount of the components and is open to include other emulsifying agents other than emulsifying crosslinked silicone elastomer.

**Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tachibana and Tchinnis as applied to claims 1-10, 12-13 as above, and further in view of Hawley, G.G., The Condensed Chemical Dictionary, 10<sup>th</sup> Ed., Van Nostrand Reinhold Co., New York (1981) pages 121, 385, 434 and 686.**

Tachibana teaches all the limitations of the claims as stated in the 35 USC 103(a) rejection above. It does not teach the preservatives of instant claim 11. Tachibana does teach that the composition contains preservatives. The preservatives of instant claim 11 are conventional substances used in the cosmetic art.

According to Hawley, disodium ETA, phenoxyethanol and methylparaben are all known preservatives. Benzyl alcohol is also known for use in cosmetics.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add anyone of the preservatives above to the composition of Tachibana for their known antimicrobial effects.

### ***Response to Arguments***

Applicant's arguments filed on July 15, 2009 have been fully considered but they are not persuasive.

Relying on the 1.132 declaration filed on November 2, 2007, applicant asserts that it is not within the ordinary skill in the art to select the droplet size and particle size disclosed in the claimed composition. Applicant also states that a formulator needs prior knowledge of the physical dimensions of the emulsifying composition he or she is working with and cannot rely on mixing or agitation energy to formulate within a given droplet size. In response, the presently claimed invention is an emulsion comprising the same siloxane emulsifying agents taught by the prior art, without any restriction as to how the composition is made; whether a skilled artisan had the knowledge of the physical dimensions of this particular emulsifier is not a determining factor as to whether the present emulsion is novel or nonobvious. Applicant has presented no evidence to show the present composition positively results in an unexpected or greater than expected result compared to the prior art. In fact, applicant states in specification, on page 6, last paragraph and page 20, first paragraph, that organopolysiloxanes and emulsifiers well known in the arts are used to make the present invention, which implies that one of ordinary skill in the art would have had sufficient knowledge of properties of the emulsifiers used in the claimed composition. Thus, the particle distribution limitation

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of claim 1 is viewed as the resulting property of the emulsion made according to the teachings and suggestion of the prior arts.

In response to applicant's assertion that the present specification is "replete" with explanation why the droplet size is critical to the present invention, the quoted passage of the specification, p. 11, bridging paragraph only describes the particle size distribution of the resulting product, but does not further explain the alleged criticality of the droplet size. The examples of the specification, on the other hand, merely teaches the formulation and method of mixing to make the claimed composition, but does not indicate any evidence that the particle size distribution was somehow "selected" to make the present composition.

Applicant also argues Tachibana neither identifies a need to prevent agglomeration of the solid particles in a cosmetic product or upon application to the skin. In response to applicant's argument that Tachibana fails to recognize such effect of the present invention, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the prior art teaches and suggests the presently claimed composition comprising cosmetic powder and the silicone emulsifiers of the present invention, and applicant's particular motivation to prevent agglomeration of the solid particles needs not be identified for a skilled artisan to make the composition according to the teachings of the reference.



Applicant's arguments regarding the rejection made further in view of Hawley depend on the validity of the Tachibana/Tchinnis rejection, which is maintained for reasons of record. Thus applicant's arguments here are rendered moot.

For above reasons, applicant's arguments are viewed unpersuasive, and the rejections are maintained.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605.

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The examiner can normally be reached on Monday through Thursday, from 8:00AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GINA C. YU/  
Primary Examiner, Art Unit 1611